

IN THE DRAWINGS

Figures 12A-14 have been objected to because they should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. The drawings are also objected to as failing to comply with 37 C.F.R. § 1.84(p) (4) because reference character “20” has been used to designate both a “recess portion” and “a movable anvil” as shown in the specification, page 16, lines 23-24.

Applicants respectfully submit herewith under separate cover two (2) sheets of replacement drawings to substitute for the originally filed drawing. Figures 12A-14 have been amended to include the legend “Prior Art”, as suggested by the Examiner in the Office Action. The specification has been corrected so that the movable anvil is now designated as reference number “19.” Accordingly, Applicants amend Figures 12A-14 to overcome the objections.

REMARKS

Summary of the Office Action

The Title has been objected to because it is deemed to be non-descriptive.

Claim 2 is objected to under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 5 and 7 are objected to under 37 C.F.R. § 1.75 as being a substantial duplicate limitation of claim 1.

Claims 1-7 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U. S. Patent No. 4,573,625 to Olesen et al. ("Olesen").

The Abstract is objected to because it is in claim format.

Figures 12A-14 have been objected to because they should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. The drawings are also objected to as failing to comply with 37 C.F.R. § 1.84(p) (4) because reference character "20" has been used to designate both a "recess portion" and "a movable anvil" as shown in the specification, page 16, lines 23-24.

Summary of the Response to the Office Action

The Title has been changed. Claims 1-4 and 6 are presently pending for further consideration. Claims 2 and 7 have been amended. Claim 5 has been cancelled. Claim 8 has been added. The drawings and specification have been amended to overcome the objections. The Abstract has been amended to overcome the objection.

Rejection Under 35 U.S.C. § 112, Second Paragraph

Claim 2 is objected to under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 2 has been amended to overcome the rejection.

Rejection Under 37 C.F.R. § 1.75

Claims 5 and 7 are objected to under 37 C.F.R. § 1.75 as being a substantial duplicate limitation of claim 1. Claim 5 has been cancelled. Claim 7 has been amended.

Rejection Under 35 U.S.C. § 102(b)

Claims 1-4 and 6 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Olesen.

The Office Action states “that the recitation that an element is ‘capable of’ performing a function is not a positive limitation but only requires the ability to so perform [and that] [i]t does not constitute a limitation in any patentable sense.” Thus, the limitation “wherein the forming plate is capable of forming the staple member ...” was given little consideration. Applicants respectfully disagree with the assertion that the phrase is not a positive limitation.

In the case, *In re Hutchison*, 69 U.S.P.Q. 138 (C.C.P.A. 1946), used to support the statement, the claim at issue was actually rejected for two reasons. One was that the phrase using the word “adapted” “did not constitute a limitation in any patentable sense.” *Id.* at 141. The other was that, even if the phrase did constitute a limitation, it was anticipated by the cited prior art. *Id.* Because the rejection had two bases, the case should be considered *dicta* for the proposition that is asserted in the Office Action.

Later cases have affirmed that statements of functional ability may be considered acceptable claim limitations. For example, it was held that the limitation used to define a radical

on a chemical compound as “incapable of forming a dye with said oxidizing agent,” although functional, was perfectly acceptable because it set definite boundaries on the patent protection sought. *In re Barr*, 444 F.2d 588, 170 U.S.P.Q. 33 (C.C.P.A. 1971).

Similarly, in a claim that was directed to a kit of component parts capable of being assembled, the court held that limitations such as “members adapted to be positioned” and “portions ... being resiliently dilatable whereby said housing may be slidably positioned” serve to precisely define present structural attributes of interrelated component parts of the claimed assembly. *In re Venezia*, 530 F.2d 956, 189 U.S.P.Q. 149 (C.C.P.A. 1976).

Similarly, the phrase “wherein the forming plate is capable of forming the staple member ...” precisely defines the structural attributes of interrelated components of the present invention. In light of this, Applicants respectfully traverse the rejection of claim 1 under 35 U.S.C. § 102(b) as being anticipated by Olesen.

The Office Action further states that “the structure of Olesen’s forming plate is capable of forming the staple members as claimed.” Applicants respectfully disagree.

The forming plate recited in claim 1 is capable of forming two staples, the staple being struck and the staple connected to it, simultaneously. In most cases, the staple being struck will already have been formed during the striking of the previous staple. However, the ability to form the first two staples simultaneously is important when loading a new cartridge, as there will have been no connected staple previously struck during which the first staple would be formed.

Olesen does not disclose or suggest the ability to form two staples at once as recited in claim 1. It is clear from Figs. 5, 6, and 9-11 of Olesen that only one staple is formed at a time. In addition, the specification of Olesen describes the feeding of “another staple blank into the notch

64 in the block 60” upon the driver 80 and former 70 returning to their normal positions after forming and striking a staple. (Col. 9, lines 18-19.) In addition, the specification of Olesen states that “[t]he feeding of staple wires 200 to block 60 is such that wires 200 are not urged toward block 60 during that portion of the downward stroke when the lead wire is first contacted by former member 70 and broken away from the belt 94.” (Col. 9, lines 26-30; emphasis added.) Thus, it is clear from the descriptions (“staple blank”, “lead wire”) of the components entering block 60 to be struck that those components have not yet been formed into staples.

The advantage of forming the second staple is apparent from the description of the problem of the last staple rotating on page 5 of the specification. Forming the second staple while it is still connected to the staple being struck eliminates the problem of the last staple rotating before being struck, thus resulting in a jammed staple.

Further, in the present invention, staples are subjected twice to a forming process to form a C-shape. The double forming processes reduce the amount of spring back and spreading of the staple legs. These factors minimize staple jamming and improve reliability of the stapler.

Because Olesen does not disclose or suggest the limitation “wherein the forming plate is capable of forming the staple member ...” recited in claim 1, Applicants respectfully request that the rejection of claims 1-4, and 6 under 35 U.S.C. § 102(b) as being anticipated by Olesen be withdrawn.

For at least the foregoing reasons, Applicants respectfully assert that claim 1 and its dependent claims 2-4, and 6-8 are in condition for allowance.

CONCLUSION

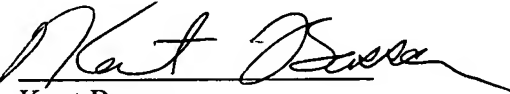
It is respectfully submitted that all claims are now in condition for allowance, early notice of which would be appreciated. Should the Examiner disagree, Applicants respectfully request a telephonic or in-person interview with the undersigned attorney to discuss any remaining issues and to expedite the eventual allowance of the claims.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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